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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,984	06/20/2003	Kurt R. Carlson	NGC-140/000047-199	7137
32205	7590	06/30/2010		
Carmen Patti Law Group, LLC ONE N. LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			EXAMINER ZEMEL, IRINA SOPHIA	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 06/30/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/600,984

Applicant(s)

CARLSON ET AL.

Examiner

Irina S. Zemel

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 7-13 and 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 14-15, 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3 and 14-15, 24, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by EO 752603 to W.L. Gore and Associates (hereinafter "W.L. Gore") as evident from "Poisson's Ratio of Foamed Plastics" by Dement'ev et al., (hereinafter "Dement'ev").

The rejection stands as per reasons of record.

Claim Rejections - 35 USC § 103

Claims 1-4, 15 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 660082 to Andrew A.G as evident from "Poisson's Ratio of Foamed Plastics" by Dement'ev et al., (hereinafter "Dement'ev").

The rejection stands as per reasons of record.

The burden is shifted to the applicants to provide factual evidence to the contrary.

The invention as claimed, thus, would have been obvious from the disclosure of the reference.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrew A.G. in combination with US 5,706,175 to Takei (as

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evident form "Poisson's Ratio of Foamed Plastics" by Dement'ev et al., (hereinafter "Dement'ev").

The rejection stands as per reasons of record.

Claims 1-3 and 15, 24, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO99/36820 to SUN Microsystems Inc., (hereinafter "SUN") in combination with US Patent 4,107,354 to Wilkenloh et al., (hereinafter "Wilkenloh") or W.L. Gore (as evident form "Poisson's Ratio of Foamed Plastics" by Dement'ev et al., (hereinafter "Dement'ev"))).

The rejection stands as per reasons of record.

Response to Arguments

Applicant's arguments filed 4-12-2010 have been fully considered but they are not persuasive. The only argument presented by the applicants in their response is that "the Office has not met its burden to fully develop reasons supporting its reliance on the doctrine of inherency". Specifically, the prior art does not expressly teach the claimed limitation of "introduction of the plurality of voids into the polymeric material effects a decrease in a bulk modulus of the polymeric material without substantially altering a Young's modulus of the polymeric material."

The examiner agrees that the references cited in the rejection do not expressly disclose this limitation, and that the examiner did rely on the inherency doctrine to meet this limitation. The examiner, however, strongly disagrees with

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the applicants only argument that the office did not meet the required burden in such reliance of the inherency of the claimed property.

While the examiner further agrees with the applicants that inherency may not be established by mere probability, there is no requirement that the inherency has to be established by any external documents or evidence as alleged by the applicants.

It is noted on the record, that the claimed limitation if a property limitation of the product produced by the claimed method, or a result in property change in the product manipulated upon by the process, i.e., reduction in bulk modulus of the polymeric material without substantially altering a Young's modulus of the polymeric material. As well established by the courts, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. See also *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

In the instant case the examiner expressly discussed why it is reasonable believed that the claimed limitations are inherently met by the product disclosed in the prior art, (specifically because the product of the prior art is obtained by substantially identical process as the process disclosed in the instant application). Contrary to the applicants arguments and allegations, this reasonable believe (which is based on the reasoned facts and arguments) is, as established by the court decisions, is enough to meet the burden placed on the Office to establish the prima facie case of obviousness. Also, as evident from the court decisions and established case law, after establishing such case of prima facie obviousness (base on sound basis for believing that the product of the applicants is the same as the product of prior art), the burden is legally shifted to the applicants to provide evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. The applicants failed to provide such evidence or even reasonable arguments that the product of the prior art that is obtained by substantially identical process as one described in the instant specification does not exhibit the claimed properties, i.e., decrease in a bulk modulus of the polymeric material without substantially altering a Young's modulus of the polymeric material.

The applicants further argue that the claimed invention is fully enabled by the numerous illustrative examples. This arguments misses the points raised by the examiner. The examiner did not reject the claimed invention as being not enabled. In fact, the examiner believes that the invention is enabled as claimed, since the claimed property of decrease in a bulk modulus of the polymeric

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material without substantially altering a Young's modulus of the polymeric material is an inherent result of the disclosed and claimed process, and therefore, is inherently enabled by the claimed process. The examiner stated that in case the applicants do not regard the claimed property or claimed results in property change as an inherent property or inherent result of the claimed process, then, and only then, the question of enablement would and should be raised since the specification provides no guidance of what specific manipulative process steps result in the claimed characteristics of the product. Since the process disclosed in the prior art is substantially identical to the one of the processes disclosed in the instant specification, and has all the same manipulative steps, the examiner has a basis to conclude that the claimed limitation of "introduction of the plurality of voids into the polymeric material effects a decrease in a bulk modulus of the polymeric material without substantially altering a Young's modulus of the polymeric material" is inherently met, and, thus, inherently enabled, by the process disclosed in the prior art. However, as stated in the previous office action, since no expressed guidance is provided in the specification as to what it takes (in terms of manipulative process steps) to actually meet this limitation, the process may be regarded as not enabling is the applicants argue that the claimed limitation is not inherent.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

Irina S. Zemel
Primary Examiner
Art Unit 1796

ISZ